REMARKS

I. STATUS OF THE CLAIMS

Claims 1-3, 5-6, 10-11, 13-14, 24, 33 and 38 are pending in the present application. Claims 1 and 10 are the independent claims.

Claims 4, 12, 36 and 37 have been cancelled without prejudice to or disclaimer of the subject matter recited therein.

Claims 1, 10 and 24 have been amended. No new matter is believed to have been added.

Claims 15-23, 32, 34 and 35 are withdrawn from consideration.

II. THE OBJECTION TO THE SPECIFICATION

The amendment filed April 21, 2004 is objected as introducing new matter into the disclosure. Applicants respectfully traverse this objection. Nonetheless to expedite the prosecution of this case, Applicants have cancelled claims 36 and 37 without prejudice to or disclaimer of the subject matter recited therein.

Accordingly, Applicants respectfully request that the objection to the amendment filed April 21, 2004 be withdrawn.

III. THE REJECTION OF CLAIMS 36-37 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 36 and 37 have been cancelled without prejudice to or disclaimer of the subject matter recited therein.

Accordingly, the rejection of claims 36 and 37 is now moot.

IV. THE REJECTION OF CLAIMS 1-3, 10-11 AND 36-39 UNDER 35 U.S.C. §102(b) AS BEING ANTICIPATED BY JAPANESE PUBLICATION 09-171813 HIROSHI

Applicants respectfully traverse this rejection for at least the following reasons.

Independent claim 1, as amended, recites, a positive active material composition for a rechargeable lithium battery comprising amongst other novel aspects, at least one additive compound, wherein said at least one additive compound comprises an amount

at or between 0.1 weight % and 1 weight % based on the weight of the positive active material composition.

Hiroshi discloses a non-aqueous electrolyte battery having a positive electrode active material covered with an inorganic ion conductive membrane (abstract). Hiroshi fails to teach or suggest the amount of the inorganic conductive material included in the membrane. Accordingly, Hiroshi fails to teach or suggest that the at least one additive compound comprises an amount at or between 0.1 weight % and 1 weight % based on the weight of the positive active material composition, as recited in newly amended independent claim 1.

Accordingly, Applicants respectfully assert that the rejection of claim 1 under 35 U.S.C. § 102(b) should be withdrawn because Hiroshi fails to teach or suggest each feature of independent claim 1, as amended.

Furthermore, Applicants respectfully assert that dependent claims 2-3 and 38-39 are allowable at least because of their dependence from claim 1, and the reasons set forth above.

Additionally, claims 36 and 37 have been cancelled without prejudice or disclaimer, thus rendering the rejection of these claims moot.

Independent claim 10, as amended, recites, a positive active material composition for a rechargeable lithium battery comprising amongst other novel aspects, at least one additive compound, wherein said at least one additive compound comprises an amount at or between 0.1 weight % and 1 weight % based on the weight of the positive active material composition.

As noted above, Hiroshi fails to teach or suggest such novel aspect of the present invention.

Accordingly, Applicants respectfully assert that the rejection of claim 10 under 35 U.S.C. § 102(b) should be withdrawn because Hiroshi fails to teach or suggest each feature of independent claim10, as amended.

Furthermore, Applicants respectfully assert that dependent claim 11 is allowable at least because of its dependence from claim 10, and the reasons set forth above.

V. THE REJECTION OF CLAIMS 1-6, 10-14, 24, 33, 36-39 UNDER 35 U.S.C. §103(a) AS

BEING UNPATENTABLE OVER AMATUCCI IN VIEW OF HIROSHI

Applicants respectfully traverse this rejection for at least the following reasons.

Independent claim 1, as amended, recites, a positive active material composition for a rechargeable lithium battery comprising amongst other novel aspects, at least one additive compound, wherein said at least one additive compound comprises an amount at or between 0.1 weight % and 1 weight % based on the weight of the positive active material composition.

Amatucci discloses a positive electrode comprising a lithiated composition particulate having a positive electrode coated with a passivating layer (abstract). The passivating layer disclosed by Amatucci, acts as an unwanted barrier preventing the movement of lithium ions.

Furthermore, Amatucci fails to teach or suggest the additive compound comprising an amount at or between 0.1 weight % and 1 weight % based on the weight of the positive active material composition, as recited in newly amended independent claim 1. Accordingly, Amatucci fails to teach or suggest, the features recited in independent claim 1.

Hiroshi, as noted above, fails to cure these deficiencies.

Accordingly, Applicants respectfully assert that the rejection of claim 1 under 35 U.S.C. § 103(b) should be withdrawn because neither Hiroshi nor Amatucci whether taken singly or combined teach or suggest each feature of independent claim 1, as amended.

Furthermore, Applicants respectfully assert that dependent claims 2-3, 5-6, 24 and 38-39 are allowable at least because of their dependence from claim 1, and the reasons set forth above.

Claims 4, 36 and 37 have been cancelled without prejudice or disclaimer. Accordingly, the rejection of claims 4, 36 and 37 is now moot.

Independent claim 10, as amended, recites, a positive active material composition for a rechargeable lithium battery comprising amongst other novel aspects, at least one additive compound, wherein said at least one additive compound comprises an amount at or between 0.1 weight % and 1 weight % based on the weight of the positive active material composition.

As noted above, Amatucci fails to teach or suggest such novel aspect of the present invention and Hiroshi fails to cure the deficiencies of Amatucci.

Accordingly, Applicants respectfully assert that the rejection of claim 10 under 35 U.S.C. §103(a) should be withdrawn because neither Amatucci nor Hiroshi, whether taken singly or combined teach or suggest each feature of independent claim 10, as amended.

Furthermore, Applicants respectfully assert that dependent claims 11, 13-14 and 33 are allowable at least because of their dependence from claim 10, and the reasons set forth above.

VI. THE REJECTION OF CLAIMS 1-6, 10-14, 24, 33 AND 36-37 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER CLAIMS 1-3, 11 AND 15 OF U.S. PATENT NO. 6,797,435

On page 10 of the Office Action, the Examiner provisionally rejects claims 1-6, 10-14, 24, 33 and 36-37 under the judicially created doctrine of obviousness-type double patenting in view of claims 1-3, 11 and 15 of U.S. Patent No. 6,797,435.

Since claims 1-6, 10-14, 24, 33 and 36-37 of the instant application have not yet been indicated as allowable, it is believed that any submission of a Terminal Disclaimer or arguments as to the non-obvious nature of the claim would be premature. MPEP 804(I)(B).

As such, it is respectfully requested that the applicant be allowed to address any provisional obviousness-type double patenting issues remaining once the rejections of the claim under 35 U.S.C. §§ 112, 102 and 103 are resolved.

VII. THE REJECTION OF CLAIMS 1-6, 10-14, 24, 33 AND 36-37 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER CLAIMS 1-5, AND 12-17 OF U.S. PATENT NO. 6,753,111

On pages 11 and 12 of the Office Action, the Examiner provisionally rejects claims 1-6, 10-14, 24, 33 and 36-37 under the judicially created doctrine of obviousness-type double patenting in view of claims 1-5 and 12-17 of U.S. Patent No. 6,753,111.

Since claims 1-6, 10-14, 24, 33 and 36-37 of the instant application have not yet

been indicated as allowable, it is believed that any submission of a Terminal Disclaimer or arguments as to the non-obvious nature of the claim would be premature. MPEP 804(I)(B).

As such, it is respectfully requested that the applicant be allowed to address any provisional obviousness-type double patenting issues remaining once the rejections of the claim under 35 U.S.C. §§ 112, 102 and 103 are resolved.

VIII. THE REJECTION OF CLAIMS 1-6, 10-14, 24, 33 AND 36-37 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER CLAIMS 1-15, 28-30 AND 32-35 OF CO-PENDING APPLICATION NO. 10/189,384

On page 13 of the Office Action, the Examiner provisionally rejects claims 1-6, 10-14, 24, 33 and 36-37 under the judicially created doctrine of obviousness-type double patenting in view of claims 1-15, 28-30 and 32-35 of co-pending Application No. 10/189,384 (U.S. Patent Application Publication NO. 2003/54250).

Since claims 1-6, 10-14, 24, 33 and 36-37 of the instant application have not yet been indicated as allowable, it is believed that any submission of a Terminal Disclaimer or arguments as to the non-obvious nature of the claim would be premature. MPEP 804(I)(B).

As such, it is respectfully requested that the applicant be allowed to address any provisional obviousness-type double patenting issues remaining once the rejections of the claim under 35 U.S.C. §§ 112, 102 and 103 are resolved.

IX. THE REJECTION OF CLAIMS 1-6, 10-14, 24, 33 AND 36-37 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER CLAIMS 1-15 AND 23-38 OF CO-PENDING APPLICATION NO. 10/072,923

On page 16 of the Office Action, the Examiner provisionally rejects claims 1-6, 10-14, 24, 33 and 36-37 under the judicially created doctrine of obviousness-type double patenting in view of claims 1-5 and 23-28 of co-pending Application No. 10/072,923 (U.S. Patent Application Publication 2003/3352).

Since claims 1-6, 10-14, 24, 33 and 36-37 of the instant application have not yet been indicated as allowable, it is believed that any submission of a Terminal Disclaimer or arguments as to the non-obvious nature of the claim would be premature. MPEP 804(I)(B).

As such, it is respectfully requested that the applicant be allowed to address any provisional obviousness-type double patenting issues remaining once the rejections of the claim under 35 U.S.C. §§ 112, 102 and 103 are resolved.

X. THE REJECTION OF CLAIMS 1-6, 10-14, 24, 33 AND 36-37 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER CLAIMS 1-10 AND 25-37 OF CO-PENDING APPLICATION NO. 09/897,445

On page 18 of the Office Action, the Examiner provisionally rejects claims 1-6, 10-14, 24, 33 and 36-37 under the judicially created doctrine of obviousness-type double patenting in view of claims 1-10 and 25-37 of co-pending Application No. 09/897,445 (U.S. Patent Application Publication 2002/71990).

Since claims 1-6, 10-14, 24, 33 and 36-37 of the instant application have not yet been indicated as allowable, it is believed that any submission of a Terminal Disclaimer or arguments as to the non-obvious nature of the claim would be premature. MPEP 804(I)(B).

As such, it is respectfully requested that the applicant be allowed to address any provisional obviousness-type double patenting issues remaining once the rejections of the claim under 35 U.S.C. §§ 112, 102 and 103 are resolved.

XI. THE REJECTION OF CLAIMS 1-6, 10-14, 24, 33 AND 36-37 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER CLAIMS 1-10 AND 25-37 OF CO-PENDING APPLICATION NO. 10/627,725

On page 21 of the Office Action, the Examiner provisionally rejects claims 1-6, 10-14, 24, 33 and 36-37 under the judicially created doctrine of obviousness-type double patenting in view of claims 1-10 and 25-37 of co-pending Application No. 10/627,725 (U.S. Patent Application Publication 2004/18429).

Since claims 1-6, 10-14, 24, 33 and 36-37 of the instant application have not yet been indicated as allowable, it is believed that any submission of a Terminal Disclaimer or arguments as to the non-obvious nature of the claim would be premature. MPEP 804(I)(B).

As such, it is respectfully requested that the applicant be allowed to address any provisional obviousness-type double patenting issues remaining once the rejections of the claim under 35 U.S.C. §§ 112, 102 and 103 are resolved.

XII. CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 50-3333.

Respectfully submitted,

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